

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 27, 2005 the Examiner Objected to claims 11 and 24 and rejected claims 11-15, 21-24, and 26-30. Applicant respectfully amends and traverses.

### Claim Objections

The Examiner objected to claims 11 and 24 as containing internally inconsistent terms and objected to claim 11 as containing matter without proper antecedent basis in the specification. Applicant submits that the claims as amended correct any problems. Specifically, Applicant has adopted the suggestions made by the examiner regarding claim 11, and Applicant has replaced problematic claim 24 with new claim 35 that does not include the objectionable language. Applicant therefore submits that the amended claims are now in condition for allowance and requests favorable reconsideration of the claims.

### Rejections under 35 U.S.C. § 112

#### **a. 112 first paragraph**

The Examiner rejected claims 11 and 24 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner states that the negative limitation of “free from etching and laser exposure and pressure” is new matter not contained in the original disclosure. Applicant has amended the objectionable language in claim 11 and has cancelled claim 24 and replaced it with new claim 35 which Applicant hopes more clearly claims the instant invention. In claim 11, the phrase “free from etching and laser exposure and pressure” has been

replaced with the more limited phrase “free from etching or cut designs.” New claim 35 also contains this amended limitation.

MPEP § 2173.05(i) regarding Negative Limitations specifically states that “[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.” (citing *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977)). As noted by the Examiner in the Office Action, page 7 line 22 through page 8 line 1 of the specification as originally filed recites that the image may be provided onto an organic product by means of etching or cutting, among other methods. Therefore, according to MPEP § 2173.05(i), the negative claim limitation “free from etching or cut designs” is properly supported by the specification as originally filed. Therefore, Applicant respectfully requests that the rejection based on the cited language be withdrawn.

Given the prosecution history of this Application, Applicant feels that additional comments regarding this amendment are merited. In the past, the Examiner has rejected claims regarding the present invention as being anticipated by or obvious in light of U.S. Pat. No. 6,172,328 to Jones et al (hereinafter Jones). Applicant respectfully submits that the claim as amended is neither anticipated by nor obvious in light of Jones. Jones specifically indicates that the laser markings provided necessarily work by the laser “etching” or “cutting” the surface of the flower or plant. (See Abstract line 1; Col. 1, lines 12-15; Col. 3, lines 21-29; Col. 4, lines 21-25.) Therefore, Applicant respectfully submits that Jones teaches away from the present invention, as claimed, and that the invention as claimed is neither anticipated by nor obvious in light of Jones.

**b. 112 second paragraph**

The Examiner rejected claims 11-15, 21-24 and 26-30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, regarding claim 11, the Examiner noted that the term “image” (second occurrence) lacks antecedent basis. Applicant respectfully amends the claim and submits that the amended claim overcomes the rejection. All potentially-confusing references to overlay have been removed to highlight the method of printing via a pad.

Regarding claim 13, the Examiner stated that claim 13 is unclear as confusing whether the image has been pad-printed or overlaid. Applicant submits that claim 13, as amended, in light of claim 11, as amended, corrects any confusion and properly indicates that the image is pad-printed.

Regarding claim 24, the Examiner noted that claim 24 is confusing. Applicant has cancelled that claim and replaced it with new claim 35 that does not include the confusing language.

Therefore, Applicant respectfully submits that the amendments overcome the rejections based on 35 U.S.C. § 112, second paragraph, and respectfully requests that the rejections be withdrawn.

Again, given the prosecution history of the Application, Applicant respectfully submits the following additional comments. In the past, the Examiner has rejected the invention as being anticipated by or obvious in light of U.S. Pat. No. 5,305,550 to Skonecki (hereinafter Skonecki). Each of the independent claims, amended claim 11 and new claims 35 and 36 include limitations regarding the nature of the image printed showing that the pad-printed image is repeatable and identical. Skonecki specifically teaches away from using a pad or stamp because it expressly utilizes an applicator to sequentially create an image that is not repeatable. It is impossible to modify

Skonecki to achieve the present invention as currently claimed. Therefore, Applicant respectfully submits that the invention as claimed is neither anticipated by nor obvious in light of Skonecki.

**c. Dependent Claims**


Claims 12-15, 21-23, and 26-30 are dependent from claim 11 or 35 and are therefore allowable for at least the same reasons.

### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, or if the Examiner would like to suggest amended claim language, the Examiner is invited to call the undersigned.

DATED this 19 day of July, 2005.

Respectfully submitted,



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